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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/775,202

02/01/2001

Johnny B. Corvin

UV-181

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1473 7590 06/20/2007  
FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
1211 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-8704

EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

06/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/775,202	<b>Applicant(s)</b> CORVIN ET AL.	
	<b>Examiner</b> Scott Beliveau	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,6-18,35,36 and 40-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-18,35,36 and 40-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e). The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/179,548, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In particular, the newly amended limitation such that the "selected promotion and the selected program originate from independent content sources" is not supported. Accordingly, the claims shall be examined on the basis of the application filing date or 01 February 2001.

### *Response to Arguments*

3. Applicant's arguments with respect to claims 1, 2, 6-18, 35, 36, and 40-48 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

O'Connor et al. discloses a recording system that allows for the user to record both programming and promotions and to further enable the playback of recorded material including both the programming and the promotion. The reference is silent as to the nature of the programming and promotions such that they necessarily "originate from independent content sources". For example, the reference is simply silent as to the typically regarding the fact that advertisements (such as those associated with the SuperBowl™ - Budweiser™, Pepsi™, etc.) originated from an independent source from the programming itself (Louisiana Superdome). Given that O'Connor is silent with respect to the specific content of the video other than to differentiate between programming and promotions, applicants arguments that the reference is somehow incapable to record both a program and an advertisement derived from independent content sources is without support in the reference.

As previously noted, O'Connor et al. continuously records video programming and promotions. The reference, subsequently, is merely silent regarding the type of promotions that are being displayed and consequently recorded. Zigmond et al. teaches on-the-fly replacement or insertion of advertisements wherein the particular insertion without regard to an advertising slot is described as being no different than in other embodiments of the invention (Col 16, Lines 41-43). Zigmond et al. simply switches an advertisement at the point of display with a targeted advertisement effectively resulting in a program having the

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same length albeit with different advertisements or advertisements shown in different time positions than originally intended. Accordingly, the functionality of O'Connor et al. is not destroyed as opposed to being supplemented. Rather than recording a non-targeted advertisement (-which might have originated from an independent content source in the first place) that can be displayed on a time-shifted basis, O'Connor et al. now records a targeted advertisement derived from an independent content source and provides time-shift functionality in essence, continues to function as a time-shift recording device.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 6, 7, 9-11, 35, 36, 40, and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Flickinger (US Pub No. 2005/0283796 A1).

In consideration of claim 1, Figure 1 of the Flickinger reference discloses a system for implementing a “method for providing an integrated recorded program/promotion playback asset”. The method comprises “recording a selected program for inclusion in the integrated recorded program/promotion playback asset [wherein] the program is selected by a user” as well as “recording a selected promotion for inclusion in the integrated recorded program/promotion playback asset wherein the selected promotion and the selected program

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originate from independent content sources” (Figures 2-3; Para. [0025], [0030], [0034], [0043]). The system subsequently “enables the user to playback the integrated recorded program/promotion playback asset” (Para. [0005]).

Claim 35 is rejected in light of the aforementioned teachings of Flickinger. In particular, Figure 3 illustrates a “system for providing an integrated recorded program/promotion playback asset”. The system comprises a “user input device configured to receive a user input to select a television program to be recorded” (and “user equipment” (ex. STB with HD) (Para. [0025]). The “user equipment” is “operative to . . . record the selected program for inclusion in the integrated recorded program/promotion playback asset, [wherein ] the program [is] selected by a user” as well as “record[ing] a selected promotion for inclusion in the integrated recorded program/promotion playback asset wherein the selected promotion and the selected program originate from independent content sources” (Figures 2-3; Para. [0025], [0030], [0034], [0043]). The system subsequently “enables the user to playback the integrated recorded program/promotion playback asset” (Para. [0005]).

Claims 2 and 36 are rejected wherein the “promotion is selected based upon the content of the program” (Para. [0030]).

Claim 6 is rejected wherein the method further comprises “recording both the program and the promotion on a storage unit” such as the HDD [300] (Figure 3).

In consideration of claims 7, 9-11, 40, and 42-44, the Flickinger et al. reference discloses that “promotions” may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be “recorded” at the “beginning of the program”, the “end of the

program”, the “beginning and the end of the program”, or “at any desired point within the program” (Para. [0043]). Similarly, the playback of the aforementioned recorded media may have commercials “integrated” at different points in time.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 1, 2, 6-18, 35, 36, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al. (US Pub No. 2005/0244138 A1) in view of Zigmond et al. (US Pat No. 6,698,020).

In consideration of claim 1, Figure 10 of the O'Connor et al. reference discloses a system for implementing a “method for providing an integrated recorded program/promotion playback asset”. The method comprises “recording a selected program for inclusion in the

integrated recorded program/promotion playback asset [wherein] the program is selected by a user” as well as “recording a . . . promotion for inclusion in the integrated recorded program/promotion playback asset” (Figures 11-13; Para. [00551], [0059] and [0068] – [0070]). The system subsequently “enables the user to playback the integrated recorded program/promotion playback asset” (Para. [0064]).

O’Connor et al., however, is silent regarding a “selected promotion . . . wherein the selected promotion and the selected program originate from independent content sources”. In an analogous art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. discloses “method” for targeted advertising that includes a “selected promotion . . . wherein the selected promotion and the selected program originate from independent content sources” (Col 6, Lines 3-12; Col 7, Lines 13-61; Col 8, Lines 22-39; Col 14, Lines 1-12). For example, the advertisement could originate from a third party advertisement content provider and the video from a video content provider. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O’Connor et al. with the teachings of Zigmond et al. to “record a selected promotion for inclusion in the integrated recorded/program/promotion playback asset wherein the selected promotion and the selected program originate from independent content sources” for the purpose of advantageously target, deliver, and present individually targeted advertisements to viewers (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3).

Claim 35 is rejected in light of the aforementioned combined teachings of O’Connor et al. and Zigmond et al. In particular, Figure 10 illustrates of the O’Connor et al. reference

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illustrates a “system for providing an integrated recorded program/promotion playback asset”. The system comprises a “user input device configured to receive a user input to select a television program to be recorded” [1300] and “user equipment” [1000]. The “user equipment” [1000] is “operative to . . . record the selected program for inclusion in the integrated recorded program/promotion playback asset, [wherein ] the program [is] selected by a user” as well as “record[ing] a . . . promotion for inclusion in the integrated recorded program/promotion playback asset” (Figures 11-13; Para. [00551], [0059] and [0068] – [0070]). The system subsequently “enables the user to playback the integrated recorded program/promotion playback asset” (Para. [0064]).

O'Connor et al., however, is silent regarding a “selected promotion . . . wherein the selected promotion and the selected program originate from independent content sources”. In an analogous art pertaining to video distribution systems and in particular targeted promotions associated with such, the Zigmond et al. reference discloses “system” for targeted advertizing that includes a “selected promotion . . . wherein the selected promotion and the selected program originate from independent content sources” (Col 6, Lines 3-12; Col 7, Lines 13-61; Col 8, Lines 22-39; Col 14, Lines 1-12). For example, the advertisement could originate from a third party advertisement content provider and the video from a video content provider. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify O'Connor et al. with the teachings of Zigmond et al. to “record a selected promotion for inclusion in the integrated recorded/program/promotion playback asset wherein the selected promotion and the selected program originate from independent content sources” for the purpose of advantageously

target, deliver, and present individually targeted advertisements to viewers (Zigmond et al.: Col 3, Line 45 – Col 4, Line 3).

Claims 2 and 36 are rejected wherein the “promotion is selected based upon the content of the program” (Zigmond et al.: Col 12, Line 60 – Col 13, Line 6).

Claim 6 is rejected wherein the method further comprises “recording both the program and the promotion on a storage unit” such as the HDD [1018] of O’Connor et al.

In consideration of claims 7, 9-11, 40, and 42-44, the Zigmond et al. reference discloses that “promotions” may be displayed either so as to replace existing advertisement slots or may be placed at any point in the programming. Accordingly, during the recording of such a program a promotion would be “recorded” at the “beginning of the program”, the “end of the program”, the “beginning and the end of the program”, or “at any desired point within the program” (Zigmond et al.: Col 14, Lines 1-12; Col 16, Lines 20-43). Similarly, the playback of the aforementioned recorded media may have commercials “integrated” at different points in time.

Claims 8 and 41 are rejected wherein the O’Connor et al. reference is operable to “record a flag . . . to indicate the beginning of the program during playback” so as to locate the beginning of a particular program within the storage medium (Figures 3 and 4; Para. [0032] and [0036]).

Claims 12, 13, 16-18, 45, and 48 are rejected wherein the method further comprises “receiving the program and the promotion” and “program guide data” and subsequently “storing” them on a “storage unit” comprising a “plurality of storage units” (Zigmond et al.: Figure 5; Col 12, Line 60 – Col 13, Line 6; Col 14, Lines 1-12; Col 15, Lines 24-34).

Claims 14, 15, 46, and 47 are rejected wherein the “program, the promotion, and the program guide data are received” either via a “single broadcast channel” or via a “plurality of broadcast channels” (Zigmond et al. Col 7, Lines 1-25; Col 14, Line 66 – Col 15, Line 16).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Scott Beliveau  
Primary Examiner  
Art Unit 2623

SEB

June 12, 2007